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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,334	10/31/2003	Ari Moskowitz	151P11699US01	9684

54228 7590 04/10/2006

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EXAMINER

BIANCO, PATRICIA

ART UNIT

PAPER NUMBER

• 3761

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/698,334	Applicant(s) MOSKOWITZ ET AL.	
	Examiner Patricia M. Bianco	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) 6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Transitional After Final Practice

The finality of the previous Office action is hereby withdrawn pursuant and Applicant's submission after final filed on 2/27/06 has been entered.

Response to Amendment

Claims 12-16 were cancelled in the amendment filed 02/27/06. As a result, claims 1-6 and 8-11 remain pending.

Please Note: Aside from the Transmittal sheet, all of the pages of the Amendment filed 2/27/06 list the Serial Number as "USN: 10/698,344" instead of the correct 10/698,334.

Response to Arguments

Applicant's arguments with respect to claims 6 and 8-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirsch et al. (5,385,541) in view of Martin et al. (5,156,592).

Kirsch discloses a CSF shunt having a catheter including a ventricle portion and a sinus portion, wherein a valve is operably coupled thereto. The catheter has a bend that is an angle of approximately 90 degrees and, as shown in the figures, and this bend is approximately 7 to 11 centimeters from the end of the catheter. Kirsch teaches that the angle of the bend is for placement into a brain ventricle. Kirsch further teaches that the shunt may have many other specific configurations and should not be construed to be limited to any particular location or placement (col. 5, lines 4-13 and col. 6, lines 6-10). The recitations that the ventricle portion is "*adapted for be placed into a cranium proximate a ventricle*" and that the sinus portion is "*adapted for be placed into a cranium proximate a superior sagittal sinus*" have not been considered since it has been held that the recitation that an element is "adapted for" perform a function is not a positive

limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

With respect to claim 9, the shunt is made of biocompatible material that is partially a semi-rigid material, such as Silastic.

With respect to claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the catheter of Kirsch using a material of for at least the sinus portion to be formed of a material that is 80 D, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Further, no criticality for the catheter's sinus portion to be made of a material having a material of 80 D is set forth by applicant. Applicant is also reminded that arguments toward the criticality of an element will generally be given little patentable weight. The basis for criticality should be clearly disclosed in the specification or supplied by affidavit. See *In re Cole*, 140 USPQ 230 (CCPA 1964).

With respect to claim 11, the recited limitations have been considered to be intended use limitations. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Since the limitations have not been positively claimed, it the system of Kirsch is capable of performing the recited function.

Kirsch discloses the invention substantially as claimed, see rejection *supra*; however, Kirsch fails to disclose specifically that the bend is approximately 180-degrees and does not specifically disclose that the material of the sinus portion is formed of a material having a durometer of approximately 80 (hereafter 80 D).

Martin discloses a pre-curved catheter having a bend of approximately 180-degrees (see figure 1). It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify Kirsch to have the catheter bend to be approximately 180-degrees as taught by Martin as an obvious design choice, since Kirsch teaches that the angle of the bend in the shunt may have many other specific configurations and should not be construed to be limited to any particular location or placement. Further, Applicant sets forth no criticality that the bend must be 180-degrees. Applicant sets forth in the specification at page 6, paragraph [36], that the bend, while illustrated to be approximately a 180-degree bend, other degrees of the bend are possible and contemplated. Furthermore, Applicant gives an example that another configuration of the bend could be a 90-degree bend. Applicant is also reminded that arguments toward the criticality of an element will generally be given little patentable weight. The basis for criticality should be clearly disclosed in the specification or supplied by affidavit. See In re Cole, 140 USPQ 230 (CCPA 1964).

Allowable Subject Matter

Claims 1-5 are allowed. The subject matter of the independent claims could either not be found or was not suggested in the prior art of record. The subject matter

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not found was the step of positioning the distal end/the catheter so that the end is pointing generally in an upstream direction, or retrograde, with respect to blood flow in combination with the other elements (or steps) in the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia M. Bianco whose telephone number is (571) 272-4940. The examiner can normally be reached on Monday to Friday 9:00-6:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 31st, 2006

Patricia M Bianco
Primary Examiner
Art Unit 3761

PATRICIA BIANCO
PRIMARY EXAMINER

